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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,741	02/28/2005	Kyoichi Iwata	04632.0064	8293

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EXAMINER

MASINICK, MICHAEL D

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/525,741	Applicant(s) IWATA, KYOICHI	
	Examiner Michael D. Masinick	Art Unit 2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 7-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/12/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-17 are pending in this application. This is the first office action on the merits.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11 and 12 are dependant upon claims 7 and 8 and recites "the calculating means" as a limitation which is to be further explained. There is insufficient antecedent basis for this limitation in claims 7 and 8. It is assumed that the applicant means "computing means" which would have antecedent basis from the computed processing time in claims 7 and 8. The claims are further treated as if this is the case and should be amended accordingly.

3. Claim 16 is unclear. The "relational expressions" shown do not seem to be related to anything that would effect the calculations made in claim 15. All of the expressions are related to "f" and it is unclear what these expressions are used for. Appropriate correction or explanation is required.

4. Regarding claim 17, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 7, 8, 10, and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,581,483 to Thompson et al.

7. Referring to claim 7, Thompson shows a method of setting a processing condition in a shotblasting process characterized in that a processing time is computed to attain a target dent rate from the number of dents per given dent unit area during a given period of time (column 3, lines 28-46 and Column 5, line 61 through column 6, line 12).

8. Referring to claim 8, 10, 12-16, Thompson shows a method for setting a processing condition in a shotblasting process, comprising the steps of: computing a dent unit area from a given hardness of a projection material (column 6, "a"), a given size of particles of the projection material ("given air pressure and shot size" – column 3), a given speed of the projection material projected ("given air pressure and shot size" – column 3), and a given hardness of a product to be processed (Almen Strip); computing the number of dents necessary to attain a given target dent rate (Table in column 5); and computing a processing time (Column 6, "N") from the number of dents, a projection amount, a projection material density, and a projection particle size.

9. Attention is pointed to column 3 of Thompson which states that "Coverage levels ... are described as multiples of the 100% coverage time, or saturation". This means that while Thompson does not use time in the equations in columns 4 and 6, the calculations are being done based on coverage percentage which is a known direct correlation to peening time (see column

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3). For example, it is known at a certain particle size and firing rate that 10 minutes of peening time is a 100% coverage.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 9, 11, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,581,483 to Thompson et al.

12. With respect to what has been shown above with relation to claim 8, Thompson does not specifically show that the computations are done using a computer with a memory device.

13. It would have been obvious to one of ordinary skill at the time of invention to use a standard computer with memory device and keyboard for entering the data required by the equations of Thompson and doing the calculations manually because computers are well known for their ability to make calculations far quicker than humans. It is further noted that the calculations of Thompson are likely too complicated to be done without a computer.

Allowable Subject Matter

14. Claims 1-6 are considered allowable in their current form.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D. Masinick whose telephone number is (571) 272-3746. The examiner can normally be reached on Mon-Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael D Masinick
Examiner
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